

Serial No. 09/777,002  
Reply to Office Action of May 25, 2004

### **REMARKS/ARGUMENTS**

Claims 1-31 are pending in this application. Claims 1-30 are rejected. Claims 1, 14, 15, 23 and 27 have been amended. Claims 8-11 have been cancelled.

In response to the Examiner's restriction requirement, Applicant provisionally elects, without traverse, claims 1-30. Claim 31 is withdrawn from further consideration.

Claims 14, 15 and 23 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In response, claims 14, 15 and 23 have been amended as suggested by the Examiner. No new matter has been included in claims 14, 15, and 23, and the amendments were made solely to provide proper antecedent basis in the claims. It should be noted, however, that claim 14 was additionally amended to more properly distinguish over the cited references, which is explained in further detail below.

Claim 1 is objected to as including an informality. Claim 1 has been amended to correct the informality. Claim 1 was additionally amended to more properly distinguish over the cited references, which is also explained in further detail below.

Claims 1-11 and 13-30 stand rejected under 35 USC 102(e) as being clearly anticipated by Carter et al. The rejection of claims 1-11 and 13-30, as amended, is respectfully traversed.

Claims 1, 14 and 27 have each been amended to further clarify the nature of the claimed storage nodes or storage devices. Support for the amendments is found, inter alia, in claims 8-11, which are now cancelled, as well as in the supporting specification text.

Serial No. 09/777,002  
Reply to Office Action of May 25, 2004

Claims 8-11 were specifically rejected under an "inherency" argument, which is proper under certain conditions that are described below. Support for the rejection was given by the Examiner as column 6, lines 3-21 of Carter et al.

Column 6, lines 3-21 of Carter provide only as follows:

A network system 10 includes a plurality of network nodes that access a memory space storing a structured store of data, such as a structured file system or a database. Each of the nodes includes at least a data control program which accesses and manages the structured store of data. The structured store of data may be stored in an addressable shared memory or the structured store may be stored in a more traditional fashion. For example, each node may be responsible for storing a particular element or elements of the structured store of data. In such an embodiment, the data control program can access a desired portion of the structured store using a globally unique identifier. The underlying system would translate the identifier into one or more commands for accessing the desired data, including network transfer commands. In another embodiment, the structured store of data is stored in an addressable shared memory space, which allows the nodes to transparently access portions of the structured store using standard memory access commands.

This selection from Carter et al is absolutely silent regarding the claimed political, economic, geographic, or network topological contexts.

Beyond the scope of the actual teachings of Carter et al, the Examiner has asserted that the limitations of claims 8-11, which are now incorporated into claim 1, are inherent in the structure of Carter et al.

According to MPEP Section 2112, the Examiner must provide a "rationale or evidence" tending to show inherency. "The fact that a certain result or characteristic

Serial No. 09/777,002  
Reply to Office Action of May 25, 2004

may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

It is respectfully submitted that the Examiner has not met the required burden in this case of providing evidence or a reasoning of how the structure of the cited reference to Carter et al includes the claimed political, economic, geographic, or network topological contexts.

For the reasons given above, claims 1, 14 and 27 are deemed to be allowable under 35 USC 102(e) as including bona fide limitations not taught in the cited reference, and that the inherency of these limitations has not been demonstrated. The remaining claims are deemed to be allowable as depending from an allowable base claim.

Claim 12 stands rejected under 35 USC 103(a) as being unpatentable over Carter in view of McClain (US Patent No. 5,794,254). The rejection of claim 12 under 35 USC 103(a) is respectfully traversed. Claim 12 is deemed to be allowable as depending from allowable base claim 1, as amended.

In view of the foregoing reasons, claims 1-7 and 12-30 are deemed to be allowable and the case is deemed to be in condition for allowance, which is hereby respectfully requested.

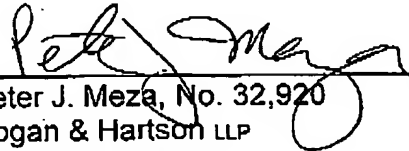
In view of all of the above, the claims are now believed to be allowable and the case in condition for allowance which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

Serial No. 09/777,002  
Reply to Office Action of May 25, 2004

No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

8/13, 2004

  
Peter J. Meza, No. 32,920  
Hogan & Hartson LLP  
One Tabor Center  
1200 17th Street, Suite 1500  
Denver, Colorado 80202  
(719) 448-5906 Tel  
(303) 899-7333 Fax